

Appl. No. : 09/818,699  
Filed : March 27, 2001

### REMARKS

In response to the Office Action, Applicant respectfully requests the Examiner to reconsider the above-captioned application in view of the following comments.

#### Discussion of Claim Rejections Under 35 U.S.C. §§ 102(b) and 103(a)

In the Office Action, the Examiner rejected Claim 1 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,785,812 to Botham, Jr. et al. (hereinafter "Botham"). Claims 5-8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Botham in view of U.S. Patent Publication No.: 20001/0001876, to Morgan, et al. (hereinafter "Morgan"). Claims 6-9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Botham in view of U.S. Patent No. 6,701,324, to Cochran, et al. and further in view of U.S. Patent No. 5,789,195, to Prihoda, et al. Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Botham in view of U.S. Patent No. 6,094,721, to Eldridge, et al.

In one embodiment, a public encryption key is associated with a client. In this embodiment, if the client sends a requests to a network server for a data file, the server automatically retrieves the public, encrypts the requested data file using the public encryption key, and sends the encrypted data file to the client.

Turning to the claims, it is seen that Claim 1 recites, among other limitations: "automatically retrieving said public encryption key from said client computer system, (3) encrypting said data file with said public encryption key in said server automatically and without user intervention." Independent Claim 5 recites: "requesting said public key from said client computer system automatically and without user intervention." Independent Claim 8 recites: "receiving a request for a data file from a client computer system; in response thereto, automatically requesting a public key from said client computer system."

Botham generally describes a secure and controlled electronic document distribution system. In Botham, a server computer encrypts a data file prior to transmitting the data file to a client computer. *See* col. 4, lines 12-18. The server computer may also define certain access rights associated with the data file using an ID that is provided by the client. *See* col. 4, lines 2-9.

Appl. No. : 09/818,699  
Filed : March 27, 2001

However, Botham fails to describe providing a public key. Furthermore, Botham fails to describe encrypting a data file using the public key of the client device.

In the Office Action, the Examiner took the position that Botham inherently teaches the above limitations. Applicant respectfully disagrees. "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to support the determination that the inherent characteristic necessarily flows from the teachings of the applied prior art." See M.P.E.P. § 2112. Thus, to the extent that a feature may be included in a system but not necessarily, it cannot be said to inherently include that feature. Applicant respectfully submits that the data that is transmitted by the server in Botham need not necessarily be encrypted by a public key of the client. In the Office Action, the Examiner acknowledged that there are at least two well-known types of key-based algorithms: symmetric and asymmetric. In view of this, it is improper to assume that Botham necessarily employs asymmetric encryption—it could employ other types of encryption. Thus, Botham cannot be said to inherently teach using a public key of a client to encrypt a data file.

Furthermore, notwithstanding the above, Applicant respectfully submits that the mere combination of asymmetric encryption by itself with Botham would not make obvious the claimed invention. Claim 1 recites: "automatically retrieving the public key from the server computer" in response a client requesting a data file from the server. Independent Claim 5 recites: "requesting said public key from said client computer system automatically and without user intervention." Independent Claim 8 recites: "receiving a request for a data file from a client computer system; in response thereto, automatically requesting a public key from said client computer system." There is no teaching in Botham *how* a public key could be transmitted from a client to the server. As is recited in independent Claims 1, 5, and 8, the public key is transmitted "automatically." Furthermore, as is recited in independent Claims 1 and 8, the key is retrieved in response to the client requesting a file from the server. There is no teaching or suggestion of at least these limitations in the cited references.

Moreover, Applicant respectfully submits that this limitation is not taught or suggested by the other cited art relied upon by the Examiner. Morgan was cited for describing persistent storage of encrypted data files. Prihoda was relied upon in the Office Action for describing the usage of file attributes. Eldridge was cited for deriving keys using passwords. Eldridge fails to

Appl. No. : 09/818,699  
Filed : March 27, 2001

describe automatically using a public key of a client device when a server transmits a data file to the client device. Applicant respectfully submits that since the cited prior art fails to teach or suggest at least the above-listed limitations, these claims are now in condition for allowance.

Summary

Applicant has endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections is respectfully requested. If the Examiner has any questions which may be answered by telephone, he is invited to call the undersigned directly.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 9/14/2005

By: E. M. Nelson

Eric M. Nelson  
Registration No. 43,829  
Attorney of Record  
Customer No. 20,995  
(619) 235-8550

1345337:sad2  
091405